

## REMARKS

### Summary of the Examiner's Actions

The Examiner objected to Claims 1, 7, 10, 11, 15, and 19 as having an informality. Applicant acknowledges the objection.

The Examiner rejected Claims 1, 5, 6, 11, 15, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Bayne, U.S. Patent Number 7,158,621 ("Bayne"), in view of knowledge common to one of ordinary skill in the art at the time the invention was made. Applicant acknowledges the rejection under 35 U.S.C. § 103(a).

The Examiner rejected Claims 7 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Bayne in view of Brawn, U.S. Patent Number 6,665,379 ("Brawn") and further in view of Pende, U.S. Patent Number 6,298,056 ("Pende"). Applicant acknowledges the rejection under 35 U.S.C. § 103(a).

The Examiner rejected Claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Bayne in view of Pende. Applicant acknowledges the rejection under 35 U.S.C. § 103(a).

The Examiner rejected Claims 2, 3, 13, 14, 17, 18, 21, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Bayne in view of Brawn. Applicant acknowledges the rejection under 35 U.S.C. § 103(a).

### Objections to the Claims

The Examiner objected to Claims 1, 7, 10, 11, 15, and 19 stating "the claims ... are marked as '**previously presented**', yet they have been amended." *Paper Number 20080605*, pg 2. Because the objected to claims were amended in Applicant's Response to the previous Office Action, having Paper Number 20071225, but are not amended in Applicant's current Response to the current Office Action, Applicant labels the claims as "Previously Presented." Although Applicant is not amending the labeling of the objected to claims, Applicant submits that the labeling is now correct because the claims are not currently being amended. Consequently,

Applicant submits that the Examiner's objection to Claims 1, 7, 10, 11, 15, and 19 is overcome and respectfully requests reconsideration of such claims and withdrawal of the objection thereto.

### **Rejections under 35 U.S.C. § 103(a)**

#### The Law of Obviousness

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

#### **35 U.S.C. §103(a).**

As discussed at MPEP § 2142, “[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.” When considering obviousness of a combination of known elements, the operative question is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S., 82 USPQ2d 1385 (2007). As discussed at MPEP § 2141, “[t]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows: (A) Ascertaining the [scope and content of the prior art]; and (B) Ascertaining the differences between the claimed invention and the prior art; and (C) Resolving the level of ordinary skill in the pertinent art.”

MPEP § 2141 also states that “[i]t must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of

ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.”

MPEP § 2141 also states that “[o]nce the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. [R]ationales that may support a conclusion of obviousness include:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

#### The Examiner’s Rejection

The Examiner rejected Claims 1, 11, 15, and 19 under U.S.C. § 103(a) as being unpatentable over Bayne stating:

Bayne discloses:

- selecting an advertisement for playback (see at least column 3, lines 44-47);
- playing said advertisement to a caller (see at least column 9, lines 59-60);

Bayne does not specifically disclose per se:

- determining whether said caller terminated playback of said advertisement.
- billing an advertiser only if said caller did not terminate playback of said advertisement;

However, Bayne in at least column 5, lines 31-38 discloses advertisers are billed for each advertisement played and in column 7, lines 5-9 discloses advertisers inducing inmate to listen to an advertisement by dialing a toll free number to access an outside line. Furthermore, Bayne in at least column 6, lines 51-67 discloses a call processing center through which the billing module keeps track of the number of times that advertisement messages are played to inmates, where the inmates will be forced to listen to one or more advertisement message as a condition, before they are able to use the service.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention that the determination of whether a playback of the advertisement was terminated is implicitly implied, since it is a procedure, required by the call center to determine if the inmates listened to the advertisement before they are allowed to make a phone call and properly bill the advertiser.

*Paper Number 20080605, pg 4.*

The Examiner rejected Claims 5 and 6 under U.S.C. § 103(a) as being unpatentable over Bayne stating:

Bayne discloses the limitations as shown above.

Bayne further discloses:

- a telephone router for routing an unanswered telephone call to said at least one server (see at least column 11, lines 36-48).

- a telephone router for routing an unanswered telephone call to said at least one server, said unanswered telephone call being directed originally to a cellular telephone user (see at least column 4, lines 7-8).

*Paper Number 20080605*, pg 4-5.

The Examiner rejected Claims 7 and 10 under U.S.C. § 103(a) as being unpatentable over Bayne in view of Brawn and further in view of Pende stating:

Bayne discloses:

- a telephone router for routing an unanswered telephone call to said at least one server (see at least column 11, lines 36-48), said unanswered telephone call being originally directed to a cellular telephone use (see at least column 4, lines 7-8);
- a storage component for advertisements and messages (see at least column 5, lines 13-16);
- an input/output component for communicating with said telephone router (see at least column 6, lines 1-17);
- selecting an advertisement for playback (see at least column 3, lines 44-47), playing said advertisement to a caller (see at least column 9, lines 59-60);

Bayne does not specifically disclose per se:

- determining whether said caller terminated playback of said advertisement,
- billing an advertiser only if said caller did not terminate playback including charging said advertiser an advertiser fee;

However, Bayne in at least column 5, lines 31-38 discloses advertisers are billed for each advertisement played and in column 7, lines 5-9 discloses advertisers inducing inmate to listen to an advertisement by dialing a toll free number to access an outside line. Furthermore, Bayne in at least column 6, lines 51-67 discloses a call processing center through which the billing module keeps track of the number of times that advertisement messages are played to inmates, where the inmates will be forced to listen to one or more advertisement message as a condition, before they are able

to use the service. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention that the determination of whether a playback of the advertisement was terminated is implicitly implied, since it is a procedure, required by the call center to determine if the inmates listened to the advertisement before they are allowed to make a phone call and properly bill the advertiser.

Bayne does not, but Pende, however does disclose:

- crediting a user a portion of said advertiser fee (see at least column 2, lines 61-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Pende's crediting subscriber of telephony service facilitation with the motivation of enhancing user experience and increasing telephone service providers' profitability and marketability.

Bayne does not, but Brown, however does disclose:

- reading a plurality of user customized said advertisement information (see at least column 11, lines 26-47);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Brown's targeting advertisement to voice messaging system based consumers information with the motivation of providing consumers with preference to customize their voice mail system in order to tailor the function of the system to their desired preferences.

*Paper Number 20080605, pg 5-6.*

The Examiner rejected Claim 8 under U.S.C. § 103(a) as being unpatentable over Bayne in view of Pende stating:

Bayne discloses:

- a means for routing an unanswered telephone call from a caller to a user see at least column 11, lines 36-48);
- a means for playing an advertisement for said caller; a means for billing an advertiser for playing said advertisement (see at least column 9, lines 59-60); and

- a means for receiving a message from said caller (see at least column 14, lines 30-31).

Bayne does not, but Pende, however does disclose:

- a means for crediting said user (see at least column 2, lines 61-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Pende's crediting subscriber of telephony service facilitation with the motivation of enhancing user experience and increasing telephone service providers' profitability and marketability.

*Paper Number 20080605*, pg 6-7.

The Examiner rejected Claim 9 under U.S.C. § 103(a) as being unpatentable over Bayne in view of Pende stating:

Bayne discloses the limitations as shown above.

Bayne further discloses:

- wherein said user is a cellular telephone user (see at least column 4, lines 7-8).

*Paper Number 20080605*, pg 7.

The Examiner rejected Claims 2, 3, 13, 14, 17, 18, 21, and 22 under U.S.C. § 103(a) as being unpatentable over Bayne in view of Brawn stating:

Bayne discloses the limitations as shown above.

Bayne does not, but Brown however does disclose:

- reading a plurality of user customized said advertisement information (see at least column 11, lines 26-47);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Brawn's targeting advertisement to voice messaging system based consumers information with the motivation of providing consumers with preference to customize

their voice mail system in order to tailor the function of the system to their desired preferences.

*Paper Number 20080605, pg 7.*

The Examiner rejected Claims 4, 12, 16, and 20 under U.S.C. § 103(a) as being unpatentable over Bayne in view of Pende stating:

Bayne discloses the limitations as shown above.

Bayne discloses:

- billing said advertiser includes charging said advertiser an advertiser fee (see at least column 5, lines 17-19) and

Bayne does not, but Pende, however does disclose:

- crediting a user a portion of said advertiser fee (see at least column 2, lines 61-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Pende's crediting subscriber of telephony service facilitation with the motivation of enhancing user experience and increasing telephone service providers' profitability and marketability.

*Paper Number 20080605, pg 7-8.*

#### Applicant's Response

Applicant submits that Bayne, in view of knowledge common to one of ordinary skill in the art, does not include all the claimed limitations of Claim 1. More specifically, Bayne does not include the at least one server of Claim 1, which "determin[es] whether said caller terminated playback of said advertisement, and bill[s] an advertiser only if said caller did not terminate playback of said advertisement." The Examiner submits that the call processing system of Bayne determines whether a caller terminates the playback of an advertisement because, as stated by Bayne at col.6, lines 59-60, "the inmate may be forced to listen to one or more such advertising messages as a condition for using the services provided by the call processing system." Further, in the words of the Examiner, "determination of whether a playback of the advertisement was terminated is implicitly implied, since it is a procedure, required by the call



center to determine if the inmates listened to the advertisement before they are allowed to make a phone call and properly bill the advertiser.” *Paper Number 20080605*, pg 4. Stated differently, the call processing system of Bayne does not determine whether the playback of an advertisement is terminated but merely assumes that the advertisement is played in its entirety each time the playback of the advertisement is initiated because the call processing system plays the advertisement prior to providing the caller with an open line. As a result, in circumstances such as when the caller initiates a call, and thus the playback of an advertisement, but terminates the call prior to the advertisement being played in its entirety, for whatever reason or even by accident, the call processing system of Bayne bills the advertiser as if the advertisement was played in its entirety. Consequently, under certain circumstances, the call processing system of Bayne unjustly bills the advertiser for the playback of an advertisement that was not played in its entirety. Additionally, it would not be obvious to one skilled in the art that a call processing system that assumes the occurrence of some event actively determines the occurrence of the event. However, the at least one server of Claim 1 actively determines whether the playback of the advertisement is terminated. And, in the event the advertisement is not played in its entirety, the at least one server of Claim 1 does not bill the advertiser for the partial playback. Stated differently, the system of Claim 1 bills an advertiser based on an active determination of whether the playback of an advertisement is terminated, whereas the call processing system of Bayne bills an advertiser based on an implication that when the playback of an advertisement is initiated, the advertisement is always played in its entirety. Considering the above discussion, Applicant submits that the call processing system of Bayne does not include the at least one server of Claim 1.

Because Bayne does not include the at least one server of Claim 1, Bayne does not include all the limitations of Claim 1. Consequently, Applicant respectfully submits that the Examiner’s rejection of Claim 1 under 35 U.S.C. § 103(a) has been overcome and respectfully requests reconsideration and allowance thereof.

The Examiner’s rejections of independent Claims 7, 10, 11, 15, and 19 are based on Bayne in the same respect that the Examiner’s rejection of Claim 1 is based on Bayne. Accordingly, Applicant respectfully submits that the Examiner’s rejections of Claims 7, 10, 11, 15, and 19 under 35 U.S.C. § 103(a) have been overcome for the reasons submitted in

Applicant's response to the Examiner's rejection of Claim 1. As a result, Applicant requests reconsideration and allowance of Claims 7, 10, 11, 15, and 19.

Considering the above discussion, Applicant respectfully submits that the Examiner's rejections of dependent Claims 2-6, 12-14, 16-18, and 20-22 under 35 U.S.C. § 103(a) have been overcome because the rejections of the respective underlying base claims have been overcome. Accordingly, Applicant respectfully requests that the Examiner reconsider and allow dependent Claims 2-6, 12-14, 16-18, and 20-22.

The Examiner rejected Claims 8 and 9 despite Applicant's cancellation of the claims in Applicant's previously submitted Response to the Examiner's previous Office Action, Paper Number 20071225. Applicant maintains the cancellation of Claims 8 and 9.

### **Summary**

In view of Applicant's arguments presented herein, Applicant submits that the above-identified patent application is in condition for the issuance of a Notice of Allowance. Such action by the Examiner is respectfully requested. If, however, the Examiner is of the opinion that the application is not in condition for the issuance of a Notice of Allowance, Applicant requests that the Examiner telephone the undersigned to expedite the prosecution of the application.

The Commissioner is authorized to charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 16-1910 (39351.00).

Respectfully submitted,

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